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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/550,138  | 09/21/2005  | Carsten Strauss      | HO-P03227US0                | 9643             |
| 26271 7590 01/30/2007<br>FULBRIGHT & JAWORSKI, LLP<br>1301 MCKINNEY<br>SUITE 5100<br>HOUSTON, TX 77010-3095 |             |                      | EXAMINER<br>CHEN, SHIH CHAO |                  |
|   |             |                      | ART UNIT<br>2821            | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE               |                  |
| 3 MONTHS  |             | 01/30/2007           | PAPER                       |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/550,138

Applicant(s)

STRAUSS ET AL.

Examiner

Shih-Chao Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/29/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on December 29, 2005 has been considered by the examiner.

### ***Specification***

3. The abstract of the disclosure is objected to because in line 20, "(Figure 1)" should be delete. Correction is required. See MPEP § 608.01(b).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. The disclosure is objected to because of the following informalities: on page 15, lines 37-38, "the coupling structure elements" should be changed to --the coupling points--.

Appropriate correction is required.

#### ***Claim Objections***

5. Claims 29 is objected to because of the following informalities: in line 1, "holder" should be changed to --the holder-- . Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 20 recites the limitation "the antenna" in line 5. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 20 recites the limitation "the mobile radio" in line 10. There is insufficient antecedent basis for this limitation in the claim.

10. Regarding claim 1, the phrase "intended for" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

11. Claim 34 recites the limitation "the mobile radio" in line 3 & 6. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 37 recites the limitation "the mobile radio" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***The Preliminary Amendment***

13. The preliminary amendment filed on September 21, 2005 is acknowledged.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 20-21 and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrotta et al. (U.S. Patent No. 5,668,561).

Regarding claim 20, Perrotta et al. teaches in figures 1-3 a holder for a mobile radio terminal, comprising: a holder [102] having an interface for connecting to an external antenna [124], and a coupling structure [100] for electromagnetic coupling of RF signals between the holder and the antenna [204] of the mobile radio terminal [202] which is located in the holder; the coupling structure being arranged in the holder in such a way that, when the mobile radio terminal is inserted, the coupling structure is

positioned underneath the mobile radio terminal in the vicinity of the mobile radio; wherein the coupling structure is in the form of a two-layer or multilayer coupling structure with two or more coupling structure elements [108, 110, 112] arranged one above the other on essentially mutually parallel planes, in which the two or more coupling structure elements are arranged one above the other and separated from one another by three to six millimeters, whereby a first coupling structure element [110] comprises two differently shaped structure elements [130] which are intended for different wavelength ranges.

Regarding claim 21, Perrotta et al. teaches in figures 1-3 the holder of claim 20, wherein the antenna [204] is a motor vehicle antenna.

Regarding claim 34, Perrotta et al. teaches in figures 1-3 the holder as claimed in claim 20, wherein the coupling structure [100] is arranged in the holder in such a way that, when the mobile radio is inserted, the coupling structure is positioned in the immediate vicinity of the antenna [204] of the mobile radio.

Regarding claim 35, Perrotta et al. teaches in figures 1-3 the holder as claimed in claim 20, wherein one coupling structure element [110] is connected to the housing of the holder [102].

Regarding claim 36, Perrotta et al. teaches in figures 1-3 the holder as claimed in claim 35, wherein the coupling structure [100] is adhesively bonded to the housing.

Regarding claim 37, Perrotta et al. teaches in figures 1-3 the holder as claimed in claim 20, wherein one coupling structure element [110] is arranged on the inner face of

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the housing of the holder [102], in the immediate vicinity of the antenna [204] of the mobile radio.

Regarding claim 38, Perrotta et al. teaches in figures 1-3 the holder as claimed in claim 20, wherein the two or more coupling structure elements [108, 110, 112] are arranged at a distance from one another on planes which are essentially parallel to one another, but the parallel planes being aligned at right angles to the main emission direction of the mobile radio terminal [202].

***Allowable Subject Matter***

16. Claims 22-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-Chao Chen whose telephone number is (571) 272-1819. The examiner can normally be reached on Monday-Thursday from 7 AM to 5:30 PM, Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan can be reached on (571) 272-1740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shih-Chao Chen  
Primary Examiner  
Art Unit 2821

*Shih-Chao Chen*  
**SHIH-CHAO CHEN**  
**PRIMARY EXAMINER**

SXC  
January 22, 2007